REMARKS

This paper is responsive to an Office Action mailed June 23, 2008. Prior to this response, claims 1-5, 7-21, and 23-31 were pending. Claims 1-5, 7-21, and 23-31 remain pending.

In Section 1 of the Office Action claims 1-5, 7-11, 17-21, and 24-26 have been rejected under 35 U.S.C 103(a) as unpatentable with respect to Pentecost et al. ("Pentecost"; US 6,919,967) in view of Tanaka. The Office Action acknowledges that Pentecost fails to disclose a copier pipeline, but that Tanaka discloses such a feature, and that it would have been obvious to combine Tanaka with Pentecost to have an image processing apparatus with an image overlaying mechanism by which image data from an inputting means source are overlaid with image data stored in memory. This rejection is traversed as follows.

Pentecost discloses a Variable Data Publishing (VDP) system that disassembles "static" text/images and variable data from a document, and downloads the static and variable data to a printer as separate entities to speed the printing process (col. 4, ln. 10-14). The analyzing software 26 first analyzes the pages from an application (i.e., a document) and identifies static page aspects and variable pages aspects, converts the static and variable pages to static data and variable data, and automatically identifies a static page layout (col. 6, ln. 31-39). A static page layout is a block of text or graphics that can be used as the background of each page in a multi-page document (col. 4, ln. 19-43). More explicitly, the analyzing software 26 analyzes pages from program

28 (in RAM 22) to identify static and variable aspects, converts the static and variable pages to static page layout objects and variable print data, and creates a PostScript or PCL data stream that is downloaded to the page printer 18 (col. 7, ln. 37-57).

The Office Action states that Tanaka teaches a copier pipeline, and that the merger unit (DMU 50) of Pentecost would not function differently because of the combination of a printer pipeline and copier pipeline. The Office Action states that it would not matter that the inputs are no longer from the same original file as taught by Pentecost, as they could still be merged pixel by pixel.

Pentecost discloses a DMU 50 for merging static page objects with variable print data, noting that additional details of the DMU 50 can be found in Vondram et al. US 5,940,585 ("Vondram") (col. 7, ln. 8-15). Generally, Vondram disclose a print data processing pipeline that employees parallel paths to handle compressed data (Vondram, col. 6, ln. 25-42). By partitioning the first data stream 201 from the second data stream 202, processing of the data elements can be optimized (Fig. 1, col. 7, ln. 33-39). More explicitly, some print data includes information compressed using a lossy format and other information compressed using a lossless format. Rather that serially processing, Vondram partitions the input page into lossy page strips and lossless page strips. After processing, the composite page strips are (re)combined (col. 8, ln. 1-39).

> "The function of the merge operation 13 is to combine, pixel by pixel, these two raster print data streams so that the original image, previously split into lossless and

lossy page strip elements, is reconstructed for the color plane being processed (col. 15, ln. 60-64)."

As with the DMU disclosed by Pentecost, Vondram discloses a merger operation which merely recombines a job that was received as a single entitle and temporarily broken apart for ease of processing. Pentecost and Vondram do not describe a process for merging 2 jobs that were originally received as separate entities, via different pipelines.

While Vondram's job is disassembled into lossy and lossless components, Pentecost's document is disassembled into static and variable components, and the static page layout objects and variable print data are sent to the printer in a single data stream with a header that identifies the static page layout and variable page data (col. 7, ln. 50-54). As with Vondram, the original document has *not* been merged with another document, just disassembled and reassembled.

The Tanaka reference has been combined with Pentecost based upon the assumption that Tanaka's copier pipeline, when combined with Pentecost discloses every limitation recited in Applicant's claims 1 and 17. However as noted above, neither Pentecost nor Tanaka disclose the merger of file from a copier pipeline with a file from a printer pipeline. Therefore, even if Tanaka's copier pipeline is combined with Pentecost, the combination does not explicitly disclose every limitation of claims 1 and 17. Claims 2-5 and 7-11, dependent from claim 1, and claims 18-21 and 24-26, dependent from claim 17, enjoy the same advantages.

The Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Pentecost and Tanaka does not explicitly disclose every limitation of claims 1 and 17. Neither has a case been supported that Pentecost can be modified to supply the missing limitations in view of Tanaka, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1-5, 7-11, 17-21, and 24-26 be removed.

In Section 14 of the Office Action, claims 13 and 28 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost and Tanaka, in view of Miura et al. ("Miura"; US 7,126,704). The Office Action acknowledges that Pentecost does not teach position commands, but that Miura discloses this feature, and that it would have been obvious to combine references for the purpose of previewing user actions. This rejection is traversed as follows.

The Miura reference has been combined with Pentecost and Tanaka based upon the assumption that Pentecost and Tanaka disclose all the limitations of independent claims 1 and 17. However as noted above, Tanaka and Pentecost do not disclose a means for merging into a single document, separate documents from copier and print pipelines. Miura also fails to teach these limitations. Therefore, even if Miura is combined with Pentecost and Tanaka, the combination still fails to disclose the above-mentioned limitations. Claim 13, dependent from claim 1, and claim 28, dependent from claim 17, enjoy the same advantages.

The Office Action states it would have been obvious to combine references for the purposes of previewing user actions. However,

this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Pentecost, Tanaka, and Miura fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Pentecost's system into one that uses inputs from both a copier and a print pipeline to create a merged document. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by previewing user actions and combine computer functions. Rather, there must be an explicit teaching in the Miura reference that shows a practitioner how Pentecost can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Pentecost and Tanaka that would make all the limitations obvious, the Applicant requests that the rejection of claims 13 and 28 be withdrawn.

In Section 16 of the Office Action, claims 14, 16, 29, and 31 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Pentecost and Tanaka, in view of Parnian et al. ("Parnian"; US 6,538,623). The Office Action acknowledges that Pentecost and Tanaka do not teach converting ASCII to PDL, but that Parnian discloses this feature, and that it would have been obvious to combine references for the purpose of adding timestamps. This rejection is traversed as follows.

The Parnian reference has been combined with Pentecost/Tanaka predicated upon the assumption that Pentecost

discloses all the limitations of independent claims 1 and 17. However as noted above, Pentecost and Tanaka do not disclose the processing of independent files via the two pipelines, and the merger of independent files. Parnian also fails to teach these limitations. Therefore, even if Parnian is combined with Pentecost/Tanaka, the combination still fails to disclose the above-mentioned limitations. Claims 14 and 16, dependent from claim 1, and claims 29 and 31, dependent from claim 17, enjoy the same advantages.

The Office Action states it would have been obvious to combine references for the purposes of adding time stamps. However, this statement does not explain how a practitioner in the art could have modified the references to yield all the claimed invention limitations. As explained above, even when combined, Pentecost, Tanaka, and Parnian fail to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Pentecost's system to independent process files for merger using both a copier and a print pipeline. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by the creation of timestamps. Rather, there must be an explicit teaching in Parnian that show a practitioner how Pentecost and Tanaka can be modified to yield the claimed invention. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Pentecost that would make all the limitations obvious, the Applicant requests that the rejection of claim 14, 16, 29, and 31 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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